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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BRYANT, DAVID P

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 10/21/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/035,452

Applicant(s)

ITO ET AL.

Examiner

David P. Bryant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/600,841.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |                                                                                               |                                                                             |
|-----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 25, 2003, has been entered.

### ***Claim Objections***

Claim 27 is objected to because of the following informalities:

This claim is dependent on claim 3, which has been canceled. Apparently, "3" is simply a typo, and should be changed to --23--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fannin (U.S. Patent No. 3,100,336) in view of Hultquist (U.S. Patent No. 4,502,317).**

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Claim 23: As shown in Figure 4, Fannin teaches a dent repair tool (i.e. a sheet member fixing device) consisting of a rod 32 having first and second ends, a hook 34 formed on the first end of the rod by bending said first end at a substantially right angle, and a handle 33 formed on the second end of the rod by bending said second end into a rectangular ring shape (see column 1, lines 63-72, and column 3, lines 70-75, where it is disclosed that the tool is formed by bending an “elongate rod-like material” into the finished shape). In use, the hook is passed through an opening 29 in an auto body sheet member 28 (see Figure 1), and is then manipulated to pull out a dent therefrom.

Fannin fails to teach (1) a handle in the shape of a circular ring, and (2) a male thread on the rod at a portion thereof near said first end, and used in combination with a nut having a female thread to secure the rod to the sheet member.

As shown in Figure 12, Hultquist teaches a dent pulling tool with a pivoting hook portion 131 and a circular ring-shaped pulling handle 50. In use, the hook portion is passed through an opening in an auto body sheet member 30/31, and the tool is then manipulated to pull out a dent in the sheet member, much like the process employed by Fannin. In Figure 13, Hultquist teaches a modification to the tool in which an outer portion thereof is threaded at 40a, and is used in conjunction with a nut 70 and a washer 72 to sandwich the auto body sheet member between the hook, washer, and nut. As disclosed by Hultquist in column 5 (lines 46-55), this embodiment securely anchors the tool to the auto body part, “which is very beneficial in auto body repair operations.”

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have bent the handle of Fannin into a circular ring shape as opposed to a rectangular

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ring shape, as taught by Hultquist, to permit the tool to be easily manipulated using only one finger, rather than the whole hand (it is also important to note that Hultquist teaches two interchangeable handles, one of rectangular shape **25** and one of circular shape **50**, which suggests that the selection of either shape is simply a matter of design choice).

It would have further been obvious to one of ordinary skill in the art at the time the invention was made to have provided male threads on the rod of Fannin near the first end thereof, and to use the threads in conjunction with a female threaded nut and a washer, as taught by Hultquist, to securely anchor the pulling tool to the auto body sheet member as the dent is being pulled out.

Claim 24: With the tool of Fannin modified as set forth above, the operation of the tool would be the same, wherein the male threaded portion of the rod would be passed through the hole from its hook's side (i.e. along with the hook).

Claim 25: With the tool of Fannin modified as set forth above, the male threaded portion of the rod is always fixed in a perpendicular orientation with respect to the hook, whether in use or not.

Claim 26: As is clear from Figure 4 of Fannin, hook **34** points in only one direction (i.e. to the right as shown).

Claim 27: The structure of nut **70** of Hultquist includes standard hex-nut flats, which would facilitate screwing the nut upon the threaded rod by hand.

### ***Response to Arguments***

Applicant's arguments filed August 25, 2003, have been fully considered but they are not persuasive.

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Applicant argues that none of the references of record teach or suggest a simple sheet member fixing device as recited in the claims. Applicant then goes on to point out individual differences in both Fannin and Hultquist. For example, applicant argues that Fannin fails to teach a circular handle and a correspondingly threaded rod and nut, while pointing out that Hultquist fails to teach a circular handle which is formed by bending one end of the rod, and provides a complicated mechanism at the end of the rod rather than a simple hook. However, it is important to note that the above rejections are based on a *combination* of Fannin and Hultquist. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant has failed to present any convincing arguments as to why the *combination* of references, resulting in a tool having precisely the structure claimed, is improper. The motivation for the combination is clearly set forth above in the body of the rejection.

### ***Conclusion***

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **David Bryant** whose telephone number is **(703) 308-1859**. Draft amendments or proposed changes to the application may be faxed directly to the examiner at any time via RightFAX at (703) 746-4213. The examiner can normally be reached on **Mondays-Thursdays from 6:30 AM to 5:00 PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Petitions/Special Programs	(703) 305-9285
Terminal Disclaimers	(703) 305-8408
PCT Help Desk	(703) 305-3257

If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line	1-800-786-9199
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David P. Bryant  
Primary Examiner  
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